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| EXAMINER | |
|---|---|
| BROWN, COURTNEY A | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/521,755 | TAKAHASHI ET AL. | |
| | Examiner | Art Unit | |
| | COURTNEY BROWN | 1616 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *07 November 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) *2 and 3* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/04/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Acknowledgement of Receipt/Status of Claims*

Receipt of Amendments/Remarks filed on November 7, 2008 is acknowledged. Claims 1-28 are pending. Claims 23-28 were added. Claims 2 and 3 are withdrawn as being directed to a non-elected invention. Claims 1 and 4-28 are being examined for patentability.

### *Information Disclosure Statement*

The Information Disclosure Statements (IDS) submitted on September 4, 2008 has been considered by the examiner.

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-7, 9, 10, and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2-6, and 15-17 of copending Application No. 11/948,542. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed subject matter embraces or is embraced by the co-pending application.

The copending application recites the same composition comprising an isoxazoline derivative represented by the compound of formula (I) and an additional herbicidal active compound such as atrazine , cyanazine and glyphosate . The difference is between the invention of the instant application and that of copending Application No. 11/948,542 is that the instant claims do not claim the use of a third herbicidal component. It would be obvious to one of ordinary skill in the art to not add a third herbicidal component because amount of the efficacy increase may not be desired for the instant claimed composition. From this extensive overlap of subject matter, one

of ordinary skill in the art would recognize that the same product is taught in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Examiner's Response to Applicant's Remarks***

Applicant's arguments filed on November 7, 2008 have been fully considered but they are not persuasive. Applicant argues that, in reference to the obviousness-types double patenting of claims 1,4-7,9, 10, and 21 over claims 1,2-6, and 15-17 of copending Application No. 11/948,542, it is appropriate for the Office to withdraw the obviousness-type double patenting rejection from the present application and enter such rejection in the case of copending Application No. 11/948,542 because the instant application is senior . However, the Examiner is only required to withdraw the obviousness-type double patenting rejection from the present application when it is in condition for allowance. Thus, the aforementioned rejection of claims 1, 4-7, 9, 10, and 21 under obviousness-types double patenting is maintained.

***Examiner's Response to Applicant's Remarks***

Applicant's arguments see pages 14-18, filed on November 7, 2008, with respect to the obviousness-type double patenting rejection of instant claim 1 over claim 8 of US Patent 7,238,689 in view of Sievernich (US Patent 6,534,444) have been fully

considered and are persuasive. For these reasons, the obviousness-type double patenting rejection of claim 1 has been withdrawn.

***New Rejection(s)***

***Double Patenting***

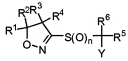
The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 18 of U.S. Patent No. 7,238,689 B2 in view of Ziemer et al. (US Patent Application 2003/0130320 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed subject matter embraces or is embraced by US Patent 7,238,689 B2.

Instant claim 1 is drawn to a herbicidal composition and patented claims 1 and 18 are drawn to a herbicide which comprises an isoxazoline derivative represented by the compound of general formula (I) (see below). The difference between the invention of the instant application and that of US Patent 7,238,689 B2 is that the invention of the instant application claims a herbicidal composition comprising an additional known herbicidal active compound such as atrazine , cyanazine and glyphosate. Ziemer et al. teach herbicidal compositions comprising at least on herbicidally active isoxazole compound (see abstract, compound of formula I of Ziemer et al.) and co-components such as clopyralid, cyanazine, dicamba, flumetsulam, imazapyr, and imazethapyr, and glyphosate (see [0084-0085]). It is known in the art that combining herbicides increase the efficacy of a herbicide such that the maximum level of control or growth regulation for a given application rate of a herbicide is increased, or alternatively, the application rate of a herbicide giving optimum control or growth regulation can be reduced. From this extensive overlap of subject matter, one of ordinary skill in the art would recognize that the same product is produced in Patent 7,238,689 B2.




**Compound of formula (I)**

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 10 of copending Application No. 10/480,376 in view of Ziemer et al. (US Patent Application 2003/0130120 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed subject matter embraces or is embraced by the co-pending application10/480,376.

Instant claim 1 is drawn to a herbicidal composition and copending claims 1 and 8 are drawn to a herbicide which comprises an isoxazoline derivative represented by the compound of general formula (I). The difference between the invention of the instant application and that of copending application 10/480,376 is that the invention of the instant application claims a herbicidal composition comprising an additional known herbicidal active compound such as atrazine , cyanazine and glyphosate. Ziemer et al. teach herbicidal compositions comprising at least on herbicidally active isoxazole compound (see abstract, compound of formula I of Ziemer et al.) and co-components such as clopyralid, cyanazine, dicamba, flumetsulam, imazapyr, and imazethapyr, and glyphosate (see [0084-0085]). It is known in the art that combining herbicides increase the efficacy of a herbicide such that the maximum level of control or growth regulation for a given application rate of a herbicide is increased, or alternatively, the application rate of a herbicide giving optimum control or growth regulation can be reduced. From this extensive overlap of subject matter, one of ordinary skill in the art would recognize that the same product is taught in the copending application10/480,376.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

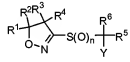
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 4-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatani et al. (US Patent 7,238,689 B2) in view of Ziemer et al. (US Patent Application 2003/0130120 A1).

***Applicant's Invention***

Applicant claims a herbicidal composition which comprises i) an isoxazoline derivative represented by the following general formula (I) or a salt



**Compound of formula (I)**

wherein R1 and R2 are independently a hydrogen atom, a C1 to C10 alkyl group, a C3 to C8 cycloalkyl group or a C3 to C8 cycloalkyl C1 to C3 alkyl group; or R1 and R2 may be bonded to each other to form a C3 to C7 spiro ring together with the carbon atoms to which they bond; R3 and R4 are independently a hydrogen atom, a C1 to C10 alkyl group or a C3 to C8 cycloalkyl group; or R3 and R4 may be bonded to each other to form a C3 to C7 spiro ring together with the carbon atoms to which they bond; or Rl, RE,

R3 and R4 may form a 5- to 8- membered ring together with the carbon atoms to which they bond; R5 and R6 are independently a hydrogen atom or a C 1 to C 10 alkyl group; Y is a 5- to 6-membered aromatic heterocyclic group or condensed aromatic heterocyclic group having one or more hetero atoms selected from a nitrogen atom, an oxygen atom and a sulfur atom; the heterocyclic group may be substituted with 0 to 6 same or different groups selected from the following substituent group ~ when the heterocyclic group is substituted at the two adjacent positions with two alkyl groups, two alkoxy groups, an alkyl group and an alkoxy group, an alkyl group and an alkylthio group, an alkyl group and an alkylsulfonyl group, an alkyl group and a monoalkylamino group, or an alkyl group and a dialkylamino group, all selected from the substituent group ~ the two groups may form, together with the atoms to which they bond, a 5- to 8-membered ring which may be substituted with 1 to 4 halogen atoms; the hetero atom of the heterocyclic group, when it is a nitrogen atom, may be oxidized to become N-oxide; n is an integer of 0 to 2; wherein said substituent group e~ is selected from the group consisting of hydroxyl group; thiol group; halogen atoms; C1 to C10 alkyl groups; C1 to C10 alkyl groups each mono-substituted with a group selected from the following substituent group 13, C1 to C4 haloalkyl groups; C3 to C8 cycloalkyl groups; C1 to C10 alkoxy groups; C1 to C10 alkoxy groups each mono-substituted with a group selected from the following substituent group ?,; C1 to C4 haloalkoxy groups; C3 to C8 cycloalkyloxy groups; C3 to C8 cycloalkyl C1 to C3 alkyloxy groups; C1 to C10 alkylthio groups; C1 to C10 alkylthio groups each mono-substituted with a group selected from the substituent group 3/; C 1 to C4 haloalkylthio groups; C2 to C6 alkenyl groups; C2 to

C6 alkenyloxy groups; C2 to C6 alkynyl groups; C2 to C6 alkynyloxy groups; C 1 to C 10 alkylsulfinyl groups; C 1 to C 10 alkylsulfinyl groups each mono-substituted with a group selected from the substituent group 3'; C 1 to C 10 alkylsulfonyl groups; C 1 to C 10 alkylsulfonyl groups each mono-substituted with a group selected from the substituent group 7; C1 to C4 haloalkylsulfinyl groups; C1 to C10 alkylsulfonyloxy groups each mono-substituted with a group selected from the substituent group 3,; C1 to C4 haloalkylsulfonyl groups; C1 to C10 alkylsulfonyloxy groups; C1 to C4 haloalkylsulfonyloxy groups; optionally substituted phenyl group; optionally substituted phenoxy group; optionally substituted phenylthio group; optionally substituted aromatic heterocyclic groups; optionally substituted aromatic heterocyclic oxy groups; optionally substituted aromatic heterocyclic thio groups; optionally substituted phenylsulfinyl groups; optionally substituted phenylsulfonyl groups; optionally substituted aromatic heterocyclic sulfonyl groups; optionally substituted phenylsulfonyloxy groups; acyl groups; C1 to C4 haloalkylcarbonyl groups; optionally substituted benzylcarbonyl group; optionally substituted benzoyl group; carboxyl group; C 1 to C 10 alkoxycarbonyl groups; optionally substituted benzyloxycarbonyl group; optionally substituted phenoxycarbonyl group; cyano group; carbamoyl group (its nitrogen atom may be substituted with same or different groups selected from C 1 to C 10 alkyl groups and optionally substituted phenyl group); C 1 to C6 acyloxy groups; C 1 to C4 haloalkylcarbonyloxy groups; optionally substituted benzylcarbonyloxy group; optionally substituted benzoyloxy group; nitro group; and amino group (its nitrogen atom may be substituted with same or different groups selected from C1 to ClO alkyl groups,

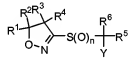
optionally substituted phenyl group, C1 to C6 acyl groups, C1 to C4 haloalkylcarbonyl groups, optionally substituted benzylcarbonyl group, optionally substituted benzoyl group, C 1 to C 10 alkylsulfonyl group, C 1 to C4 haloalkylsulfonyl groups, optionally substituted benzylsulfonyl group, and optionally substituted phenylsulfonyl group); wherein said substituent group 13 is selected from the group consisting of hydroxyl group; C3 to C8 cycloalkyl groups (which may be substituted with halogen atom or alkyl group); C1 to ClO alkoxy groups; C1 to ClO alkylthio groups; C1 to ClO alkylsulfonyl groups; C1 to ClO alkoxycarbonyl groups; C2 to C6 haloalkenyl groups; amino group (its nitrogen atom may be substituted with same or different groups selected from C 1 to ClO alkyl groups, C1 to C6 acyl groups; C1 to C4 haloalkylcarbonyl groups, C1 to ClO alkylsulfonyl groups and C 1 to C4 haloalkylsulfonyl groups); carbamoyl group (its nitrogen atom may be substituted with same or different C1 to ClO alkyl groups); C1 to C6 acyl groups; C1 to C4 haloalkylcarbonyl groups; C1 to C10 alkoxyimino groups; cyano group; optionally substituted phenyl group; and optionally substituted phenoxy group; wherein said substituent group T is selected from the group consisting of C1 to C10 alkoxycarbonyl groups; optionally substituted phenyl group; optionally substituted aromatic heterocyclic groups; cyano group; and carbamoyl group (its nitrogen atom may be substituted with same or different C 1 to C 10 alkyl groups); and

ii) at least one compound selected from the group consisting of atrazine, simazine, cyanazine, isoxaflutole, mesotrione, flumetsulam, imazethapyr, imazapyr, dicamba, clopyralid, prosulfuron, halosulfuron-methyl, rimsulfuron, bentazone, carfentrazone-

ethyl, metribuzin, thifensulfuron-methyl, nicosulfuron, primisulfuron, cloransulam-methyl, glufosinate, glyphosate, glyphosate-trimesium, pendimethalin, linuron, prometryn, diflufenican, flumioxazin, and metolachlor.

***Determination of the scope and the content of the prior art (MPEP 2141.01)***

Nakatani et al. teach a herbicide which is an isoxazoline derivative represented by the following general formula (I) or a salt



**Compound of formula (I)**

wherein R1 and R2 are independently a hydrogen atom, a C1 to C10 alkyl group, a C3 to C8 cycloalkyl group or a C3 to C8 cycloalkyl C1 to C3 alkyl group; or R1 and R2 may be bonded to each other to form a C3 to C7 spiro ring together with the carbon atoms to which they bond; R3 and R4 are independently a hydrogen atom, a C1 to C10 alkyl group or a C3 to C8 cycloalkyl group; or R3 and R4 may be bonded to each other to form a C3 to C7 spiro ring together with the carbon atoms to which they bond; or RI, RE, R3 and R4 may form a 5- to 8- membered ring together with the carbon atoms to which they bond; R5 and R6 are independently a hydrogen atom or a C 1 to C 10 alkyl group;

Y is a 5- to 6-membered aromatic heterocyclic group or condensed aromatic heterocyclic group having one or more hetero atoms selected from a nitrogen atom, an oxygen atom and a sulfur atom; the heterocyclic group may be substituted with 0 to 6 same or different groups selected from the following substituent group ~ when the heterocyclic group is substituted at the two adjacent positions with two alkyl groups, two alkoxy groups, an alkyl group and an alkoxy group, an alkyl group and an alkylthio group, an alkyl group and an alkylsulfonyl group, an alkyl group and a monoalkylamino group, or an alkyl group and a dialkylamino group, all selected from the substituent group ~ the two groups may form, together with the atoms to which they bond, a 5- to 8-membered ring which may be substituted with 1 to 4 halogen atoms; the hetero atom of the heterocyclic group, when it is a nitrogen atom, may be oxidized to become N-oxide; n is an integer of 0 to 2; wherein said substituent group e~ is selected from the group consisting of hydroxyl group; thiol group; halogen atoms; C1 to C10 alkyl groups; C1 to C10 alkyl groups each mono-substituted with a group selected from the following substituent group 13, C1 to C4 haloalkyl groups; C3 to C8 cycloalkyl groups; C1 to C10 alkoxy groups; C1 to C10 alkoxy groups each mono-substituted with a group selected from the following substituent group ?,; C1 to C4 haloalkoxy groups; C3 to C8 cycloalkyloxy groups; C3 to C8 cycloalkyl C1 to C3 alkyloxy groups; C1 to C10 alkylthio groups; C1 to C10 alkylthio groups each mono-substituted with a group selected from the substituent group 3/; C 1 to C4 haloalkylthio groups; C2 to C6 alkenyl groups; C2 to C6 alkenyloxy groups; C2 to C6 alkynyl groups; C2 to C6 alkynyloxy groups; C 1 to C 10 alkylsulfinyl groups; C 1 to C 10 alkylsulfinyl groups each mono-substituted with a

group selected from the substituent group 3'; C 1 to C 10 alkylsulfonyl groups; C 1 to C 10 alkylsulfonyl groups each mono-substituted with a group selected from the substituent group 7; C1 to C4 haloalkylsulfinyl groups; C1 to C10 alkylsulfonyloxy groups each mono-substituted with a group selected from the substituent group 3,; C1 to C4 haloalkylsulfonyl groups; C1 to C10 alkylsulfonyloxy groups; C1 to C4 haloalkylsulfonyloxy groups; optionally substituted phenyl group; optionally substituted phenoxy group; optionally substituted phenylthio group; optionally substituted aromatic heterocyclic groups; optionally substituted aromatic heterocyclic oxy groups; optionally substituted aromatic heterocyclic thio groups; optionally substituted phenylsulfinyl groups; optionally substituted phenylsulfonyl groups; optionally substituted aromatic heterocyclic sulfonyl groups; optionally substituted phenylsulfonyloxy groups; acyl groups; C1 to C4 haloalkylcarbonyl groups; optionally substituted benzylcarbonyl group; optionally substituted benzoyl group; carboxyl group; C 1 to C 10 alkoxycarbonyl groups; optionally substituted benzyloxycarbonyl group; optionally substituted phenoxycarbonyl group; cyano group; carbamoyl group (its nitrogen atom may be substituted with same or different groups selected from C 1 to C 10 alkyl groups and optionally substituted phenyl group); C 1 to C6 acyloxy groups; C 1 to C4 haloalkylcarbonyloxy groups; optionally substituted benzylcarbonyloxy group; optionally substituted benzoyloxy group; nitro group; and amino group (its nitrogen atom may be substituted with same or different groups selected from C1 to ClO alkyl groups, optionally substituted phenyl group, C1 to C6 acyl groups, C1 to C4 haloalkylcarbonyl groups, optionally substituted benzylcarbonyl group, optionally substituted benzoyl

group, C 1 to C 10 alkylsulfonyl group, C 1 to C4 haloalkylsulfonyl groups, optionally substituted benzylsulfonyl group, and optionally substituted phenylsulfonyl group); wherein said substituent group 13 is selected from the group consisting of hydroxyl group; C3 to C8 cycloalkyl groups (which may be substituted with halogen atom or alkyl group); C1 to ClO alkoxy groups; C1 to ClO alkylthio groups; C1 to ClO alkylsulfonyl groups; C1 to ClO alkoxycarbonyl groups; C2 to C6 haloalkenyl groups; amino group (its nitrogen atom may be substituted with same or different groups selected from C 1 to ClO alkyl groups, C1 to C6 acyl groups; C1 to C4 haloalkylcarbonyl groups, C1 to ClO alkylsulfonyl groups and C 1 to C4 haloalkylsulfonyl groups); carbamoyl group (its nitrogen atom may be substituted with same or different C1 to ClO alkyl groups); C1 to C6 acyl groups; C1 to C4 haloalkylcarbonyl groups; C1 to C10 alkoxyimino groups; cyano group; optionally substituted phenyl group; and optionally substituted phenoxy group; wherein said substituent group T is selected from the group consisting of C1 to C10 alkoxycarbonyl groups; optionally substituted phenyl group; optionally substituted aromatic heterocyclic groups; cyano group; and carbamoyl group (its nitrogen atom may be substituted with same or different C 1 to C 10 alkyl groups) (see claims 1 and 18 of Nakatani et al.)

***Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)***

The difference between the invention of the instant application and that of Nakatani et al. is that the invention of the instant application claims a herbicidal

composition comprising an additional known herbicidal active compound such as atrazine , cyanazine and glyphosate. For this reason, the teaching of Ziemer et al. is joined. Ziemer et al. teach herbicidal compositions comprising at least on herbicidally active isoxazole compound (see abstract, compound of formula I of Ziemer et al.) and co-components such as clopyralid, cyanazine, dicamba, flumetsulam, imazapyr, and imazethapyr, and glyphosate (see [0084-0085]).

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the two cited references to arrive at a herbicidal composition which comprises an isoxazoline derivative represented general formula (I) or a salt thereof and another known herbicide such as atrazine , cyanazine and glyphosate. Ziemer et al. teach herbicide combinations comprising a compound from the same class (isoxazoline ) and the use of the same known herbicides (such as atrazine , cyanazine and glyphosate). It is known in the art that combining herbicides increase the efficacy of a herbicide such that the maximum level of control or growth regulation for a given application rate of a herbicide is increased, or alternatively, the application rate of a herbicide giving optimum control or growth regulation can be reduced. One would have been motivated to combine these references in order to receive the expected benefit of an increase in the efficacy of the claimed isoxazoline

herbicide. Thus, in view of *In re Kerkhoven, 205 USPQ 1069 (C.C.P.A. 1980)*, it is *prima facie* obvious to combine two or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art.

None of the claims are allowed.

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***Conclusion***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electron Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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